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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

LACYK, JOHN P

ART UNIT

PAPER NUMBER

3736

DATE MAILED: 02/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/645,252

Applicant(s)

ASHENDEN, MATTHEW

Examiner

John P Lacyk

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 21-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21-39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 39 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 39 is directed to a computer program per se since the application does not make clear that the only reasonable interpretation of the word "product" is a product that includes code set forth on a tangible computer-readable medium. The broadest reasonable interpretation of the claim would be that it includes only the program per se and is therefore not proper. Applicant should refer to MPEP 2106.

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 21-39 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 21 it is unclear what the limitations of "closely defined large-scale" structure.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

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5. Claim 21-24 and 32-39 are rejected under 35 U.S.C. 102(a) as being anticipated by Mester.

Mester teaches a program memory (4), a processor (2), a sequence memory (1) and audio reproduction hardware elements (8, 10). Each grouped selections is considered to be a phase, such that within each group the music is selected at random.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 21-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rodgers in view of Mester.

Rodgers discloses the claimed apparatus for reducing stress associated with surgery and teaches using a combination of music and voice-over information relating to each phase of a surgical procedure. Rodgers teaches (column 4, lines 57-64) that the music is anxiolytic and is composed without recognizable melody, familiar rhythm or harmony that can be anticipated, which is considered to be random. Each phase has a different voice-over associated with the specific phase of the surgery. The only difference being that the Rodgers device would produce such sounds and record them on a cassette

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tape, while the claimed device generates the same sounds during the surgery based on a computer program. Mester discloses a known method, apparatus and computer program to randomly generate music within different groups. Rodgers teaches (column 3, lines 55-60) that there are frequent delays, that each type of surgery is for different lengths of time. Therefore a modification of Rodgers such that the prerecorded cassette is substituted with the program of Mester would have been obvious since this would better allow for producing sounds in each phase with more flexibility depending on the length of time for each phase of the surgery. The use of modern computer technology as taught by Mester would have provided for the sounds to be more adaptable on a real-time basis which would have been desirable in view of the variations in length of time of the different phases of a surgical procedure, which would also allow for better control to correspond the specific voice-overs to the particular phase of the surgery.

8. Applicant's arguments filed 10/22/2004 have been fully considered but they are not persuasive. Applicant argues that Mester discloses a system for generating improvised music by selection "partly at random" of music sections stored in a database and that the music selections are chosen with a random element but the selection process is not "entirely random". However claim 21 does not define that the selection process is entirely random, the claim recites the entire program is, on a detailed level, "apparently random", but has a closely defined large-scale structure. As discussed above it is unclear what the limitations of "closely defined large-scale structure" are. Further the claim recites that the program is apparently random, in which Mester would

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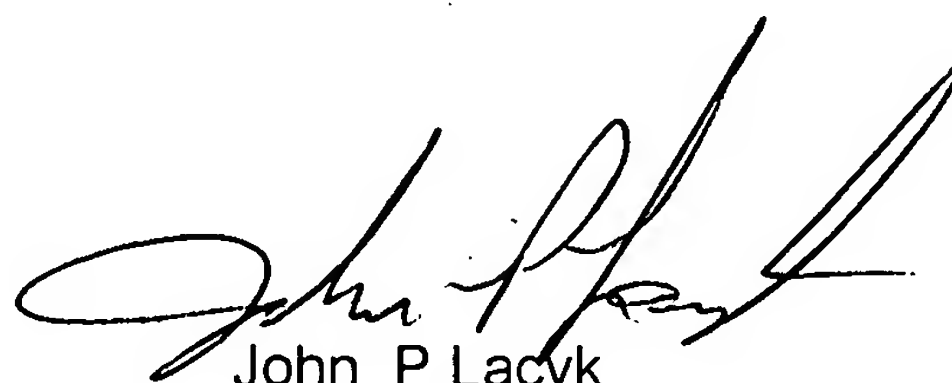
meet the limitation of "apparently random". Further the specification, page 2, lines 24-30, define random as being "pseudo-random". With regard to Mester, Applicant argues that the music selections are grouped and therefore not entirely at random, each group of music selection is chosen at random, which corresponds to each phase of the claimed device, wherein each phase is generated by selecting at random a plurality of audio sequences and each phase or group being reproduced in succession to construct a continuous phase.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John P Lacyk whose telephone number is 571-272-4728. The examiner can normally be reached on Mon-Fri, 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on 571-272-4726. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



John P Lacyk  
Primary Examiner  
Art Unit 3736

J.P. Lacyk